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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,346	03/26/2004	Russell Bonaventura	LEAP:128US	1571
7590	08/18/2006			EXAMINER PRITCHETT, JOSHUA L
S. Peter Konzel, Esq. Simpson & Simpson, PLLC 5555 Main Street Williamsville, NY 14221-5406			ART UNIT 2872	PAPER NUMBER

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/811,346	BONAVENTURA ET AL.	
	Examiner	Art Unit	
	Joshua L. Pritchett	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 July 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3,5-7 and 9-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-7 and 9-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/06.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

This action is in response to Amendment filed July 27, 2006. All applicant's arguments have been considered.

Claim Objections

Claim 14 is objected to because of the following informalities: claim 14 states, "said focus drive mean." This limitation does not have proper support. Claim 14 should depend from claim 13 to provide proper support for this limitation. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Esmay (US 4,616,517).

Regarding claim 12, Esmay discloses a focus adjustment means (22) a first focus adjustment knob (16) and a removable focus adjustment knob (20), the first focus adjustment

knob and the removable focus adjustment knob are coaxial and independently rotatable with respect to one another (Fig. 1).

Regarding claim 13, Esmay discloses the focus adjustment means comprises a rotatable shaft (22; Fig. 1; col. 2 line 61).

Regarding claim 14, Esmay discloses the focus adjustment knob is releasably fastenable to the focus drive means (col. 3 lines 66-68).

Regarding claim 15, Esmay discloses the removable focus adjustment knob is fastenable to the focus drive means by first means operatively arranged for preventing separating movement of the removable focus adjustment knob axially away therefrom and a second means tending to allow rotation of the focus drive means with the removable focus adjustment knob (col. 3 lines 66-68; Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, 9-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Bigelow (US 4,158,216).

Regarding claims 1 and 5, Esmay teaches a microscope with a removable interchangeable focus adjustment knob (20) fastenable to a focus adjustment means (col. 3 lines 66-68; Fig. 1; 22). Esmay lacks reference to magnetic connection to attach the knob. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Regarding claims 2 and 6, Esmay teaches the focus adjustment means comprises a rotatable shaft (22; Fig. 1; col. 2 line 61).

Regarding claims 3 and 7, Esmay teaches the knob adapted for complementary engagement with the focus adjustment means (col. 3 lines 66-68). Esmay lacks reference to magnetic connection to attach the knob. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Regarding claim 9, Esmay teaches a second focus adjustment means (16).

Regarding claim 10, Esmay teaches the second focus adjustment means comprises a second focusing means (18).

Regarding claim 11, Esmay teaches the removable focus adjustment knob is attachable to the second focus adjustment means (Fig. 1). Esmay lacks reference to magnetic connection to

attach the knob. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Regarding claim 16, Esmay teaches the invention as claimed but lacks reference to magnetic attachment. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Regarding claim 17, Esmay teaches the use of pin means extending axially of the removable focus adjustment knob and pin receiving means (113) complementarily extending axially of the focus drive means (Fig. 1).

Regarding claim 18, Esmay teaches the invention as claimed but lacks reference to magnetic attachment. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Regarding claim 19, Esmay teaches the focus drive means is operatively arranged for causing vertical displacement of a microscope stage (col. 1 lines 18-20).

Claims 20 and 21 rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Bigelow (US 4,158,216) as applied to claim 19 above, and further in view of Ganser (US 5,684,627).

Regarding claim 20, Esmay in combination with Bigelow teaches the invention as claimed but lacks reference to the focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esmay in combination with Bigelow microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Regarding claim 21, The prior art teaches the claimed invention except for the axial length of one focus knob being longer than another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the axial length of one of the focus knobs, since such a modification would involve only a mere change in size of a component. Scaling up or down of an element which merely requires a change in size is generally considered as being within the ordinary skill in the art. There appears to be no substantial advantage to having one knob longer than the other except for design choice or user preference.

Claims 22, 24, 26-28, 30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Ganser (US 5,684,627).

Regarding claim 22, 26, 28 and 32, Esmay teaches a focusing means comprising a removable focus adjustment knob (20) and a focus drive means (22). Esmay lacks reference to the focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). Esmay further lacks the axial length of one focus knob being longer than another. It would have been obvious to one of ordinary skill in the art at the time the invention was made to change the axial length of one of the focus knobs, since such a modification would involve only a mere change in size of a component. Scaling up or down of an element which merely requires a change in size is generally considered as being within the ordinary skill in the art. There appears to be no substantial advantage to having one knob longer than the other except for design choice or user preference. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esmay microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Regarding claims 24 and 30, Esmay teaches the use of pin means extending axially of the removable focus adjustment knob and pin receiving means (113) complementarily extending axially of the focus drive means (Fig. 1).

Regarding claim 27, Esmay teaches a focus means comprising a first coarse (16) and first removable (20) focus adjustment knobs and a drive means (22). Esmay lacks reference to the

focus adjustment means provided on opposite sides of the microscope. Ganser teaches it would be advantageous to place duplicate focus adjustment means on opposite sides of a microscope body for ergonomic purposes (col. 3 lines 65-66). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the Esamy microscope include the focus means on opposite sides of the microscope as taught by Ganser for the purpose of allowing easy operation by a person with either hand being dominant.

Claims 23, 25, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esmay (US 4,616,517) in view of Ganser (US 5,684,627) as applied to claims 22 and 27 above, and further in view of Bigelow (US 4,158,216).

Esmay in combination with Ganser teaches the invention as claimed but lacks reference to magnetic attachment. Bigelow teaches a knob (20) magnetically attachable to maintain the position of the knob (Fig. 2; abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the knob of Esmay in combination with Ganser attachable using magnetic attraction for the purpose of providing a more secure attachment to the focus adjustment means so that the knob would not easily fall off the microscope.

Response to Arguments

Applicant's arguments filed July 27, 2006 have been fully considered but they are not persuasive.

Applicant argues Esmay fails to teach independent rotation of the focus adjustment knobs. Esmay states the coarse focus knob 16 rotates shaft 18 and the fine focus knob 20 rotates shaft 22 (col. 4 lines 1-12). The examiner interprets the ability of the two knobs to rotate independent and distinct drive shafts as independent rotation of the knobs.

Applicant argues the Esmay reference fails to teach two means for attaching the knob one of which prevents axial movement and the second to allow rotation. The knob 20 is attached with a set screw 116 to prevent axial movement and a bore hole 113 to allow rotation (col. 3 lines 66-68).

Applicant argues the prior art fails to teach the removable knob is interchangeable. When manufacturing a knob such as knob 20, the knob would be made to be the same as every other knob within manufacturing error. If this were not the case then every knob would work only with a single microscope. Interchangeable parts are a keystone of modern manufacturing and would be part of any large scale production.

Applicant argues any modification of the attachment means taught by Esmay to use the magnetic fastening means would require more than just a simple modification. The examiner disagrees. The inclusion of a magnet in bore hole 113 would help to more securely attach the knob 20 to the shaft 22.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues Bigelow is not reasonably pertinent to the particular problem addressed by the current application. The Bigelow reference teaches an adjustment knob attached magnetically. The Esmay reference teaches the other limitations of the claim language, such as attachment to a shaft. The Bigelow reference is used only to show it is known in the art to attach a knob using magnetic force.

Applicant argues the prior art fails to teach or suggest a pin means extending axially of the removable focus adjustment knob. The examiner interprets the portion of shaft 22 extending into the bore hole 113 is a "pin means" within the broadest reasonable interpretation of a "pin means."

Applicant argues the use of the Ganser reference is hindsight because there is no motivation to combine the references. Ganser provides the motivation for combination for ergonomic purposes (col. 3 lines 64-67). So there is clearly a motivation for the combination provided explicitly in the references.

Applicant argues Esmay will not allow a removable adjustment knob to be attached on either side of the microscope. If the shafts 18 and 22 were extended through the microscope body, as would have to be the case with the Ganser reference the Esmay reference would be capable of attaching an adjustment knob on both sides of the microscope body.

Applicant argues the decision to have one knob with an axial length greater than another was not a mere obvious change in size of a component, but provides the option of controlling the microscope stage and fine focus adjustment from the same side of the microscope. The Esmay

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reference allows coarse and fine control from the same side of the microscope. Further, the same of the knob in no way impacts the ability of the knob to control either the stage or fine focusing of the microscope, so long as the user can access the knob. Therefore the change in the length of the knob in the axial direction is a mere obvious change in shape.

Applicant argues there is no indication by Esmay that the knobs can be alternatively fastenable to either the first or second drive means. Esmay states the knob 16 is fastenable to the drive means 18 and the knob 20 is fastenable to the drive means 22. The claim language is interpreted as requiring the knobs are releasably attached to **either** the first or second drive means not that the knobs can be attached to **both** the first and second drive means separately. (Emphasis added).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua L. Pritchett whose telephone number is 571-272-2318. The examiner can normally be reached on Monday - Friday 7:00 - 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua L Pritchett /P
Examiner
Art Unit 2872



DREW A. DUNN
SUPERVISORY PATENT EXAMINER